

## REMARKS

### **Formal Matters**

Claims 1-42 are pending and claims 20-40 are withdrawn from consideration.

Claims 1-8, 40, and 41 were examined and rejected.

Claims 9-19 were examined and objected to.

Claims 41 and 42 has been amended. Support for these amendments is found in the claims as originally filed, as well as in the specification at, for example, page 6, lines 9-14, and page 10, 9-17.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

### **Election/Restriction**

Applicants acknowledge that claims 20-40 are withdrawn from consideration as being drawn to non-elected invention.

### **Rejections under 35 U.S.C. § 112, second paragraph (indefiniteness)**

Claims 40-41 have been rejected under 35 U.S.C. §112, 2<sup>nd</sup> ¶, on the grounds that the claims are indefinite in that they fail to point out what is included or excluded by the claim language. Since claim 40 has been withdrawn for being directed to non-elected subject matter, the rejection of claim 40 is rendered moot. Furthermore, in view of the amendment to claim 41 withdrawal of this rejection is respectfully requested.

### **Rejections under 35 U.S.C. § 102(e)**

Claims 1-8 and 41-42 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,2512,601 to Bao et al. (hereinafter Bao). This rejection is respectfully traversed.

The claimed invention is directed to a method of reading an array of moieties which consists of exposing a slide containing the array to a sample, and then mounting the slide on a slide holder, followed by inserting the slide holder into an array reader and reading array. Therefore, the array is not exposed to the sample while the slide is in the slide holder.

In contrast, Bao discloses a system in which an array with the desired target elements is manufactured and then is glued into the cavity of the array holder (see Column 14, lines 63-67). Once in the array holder, the array is then exposed to a sample by the user (see Column 15, lines 1-23). Unlike the claimed invention of the present application, Bao does not disclose a method of reading an array, where a previously exposed array is first placed in an array holder and then placed in an array reader.

On page 4 of the Office Action the Examiner points to Figure 1e and column 14 and stresses that Bao discloses “processing of a slide comprising a bioarray in which the reacted slide is positioned on a holder having a cavity structure, so as to protect the bioarray from contacting a surface of the holder.” However, the Applicants note that column 14 concludes by stating that the “microarray with desired target elements is manufactured as described above, and is then glued with any suitable adhesive into the bottom of cavity 37,” (see Column 14, lines 65-66) which is depicted in Figure 1e. The specification also states that the chip holder bearing the array can then be shrink wrapped and packaged in a kit with reagents for performing a hybridization reaction by the user. Therefore, the cited section of Bao does not anticipate the claimed invention because it actually teaches a method where the array is first glued to the holder and then contacted with the sample.

The Examiner also points to column 10, lines 22-30 of Bao in rejecting claims 41 and 42. Specifically, the highlighted section of Bao discloses the use of an automated tracking and labeling method for “delivering the correct nucleic acid for depositing at a particular target,” and to “permit better computer control of the manufacturing process.” The section cited by Examiner discusses only the use of an automated tracking system only for controlling the process of manufacturing the bioarrays. The cited section does not discuss a method of positioning an array in an array reader and then reading an array through the front side and the identification code from the front side, as required in claim 41 of the

present application. The cited portion of Bao is limited to discussing array manufacturing steps, not how a fully manufactured array is read. Therefore, the cited section of Bao does not anticipate claims 41 and 42 of the present application.

It is well established that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987). See also, Scripps Clinic and Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001 (Fed. Cir. 1991).

Since the disclosed method of Bao requires exposing the array to a sample after the array is placed in the array holder instead of exposing the array to the sample prior to placing the array in the array holder, as recited in the present claims, Bao fails to disclose each and every element of the claimed invention. Furthermore, Bao fails to teach reading an identification code from a completed array, as described above. Accordingly, withdrawal of this rejection of claims 1-8 and 41-42 is respectfully requested.

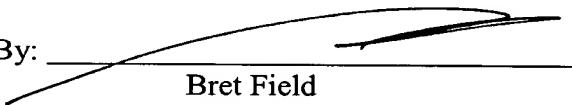
## CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: 12.12.03

By:   
Bret Field  
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP  
200 Middlefield Road, Suite 200  
Menlo Park, CA 94025  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231

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